

## **REMARKS**

### **Status of the Claims**

Upon entry of the instant amendment, claims 1, 2, 7-18, 20, 22, 23 and 28-42 are pending in this application. Claims 1, 20, 22 and 42 are independent.

Claims 1, 16, 20, 22, 41 and 42 have been amended and claims 3-6, 19, 21, 24-27 and 43 have been cancelled without prejudice or disclaimer of the subject matter contained therein. Claims 1, 20, 22 and 42 have been amended to recite elements from cancelled claims 5 and 26. Claims 16 and 41 have been amended to clarify the language. Thus, no new matter has been introduced by way of amendments made to the claims. Reconsideration of this application, as amended, is respectfully requested.

### **Common Ownership**

The present application, U.S. Pat. App. No. 10/593,183, and Iwaki, U.S. Pat. App. Pub. No. 2005/0112656 (U.S. Pat. App. No. 10/974,681) (hereinafter "Iwaki") were, at the time the invention of U.S. Pat. App. No. 10/593,183 was made, owned by Fujifilm Corporation. Thus, Iwaki is not available as prior art in accordance with 35 U.S.C. § 103(c)(1). (Iwaki was relied on in the Office Action as teaching a nucleic acid-adsorbing porous membrane comprising an organic material obtained by saponification of a mixture of acetyl celluloses different from each other in acetyl value.)

### **Priority Under 35 U.S.C. § 119**

Applicants thank the Examiner for acknowledging Applicants' claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority documents.

### **Drawings**

Applicants thank the Examiner for indicating that the drawings are accepted.

**Rejections Under 35 U.S.C. §§ 102/103**

Claims 1, 2, 7-18, 22-23 and 28-41 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Ekenberg, U.S. 6,218,531 (hereinafter “Ekenberg”).

Claim 20 stands rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Mori et al., U.S. Pat. App. Pub. No. 2003/0170664 (hereinafter “Mori”). These rejections are respectfully traversed.

After entry of the instant Amendment, claims 1, 2, 7-18, 20, 22-23 and 28-41 recite a nucleic acid-adsorbing porous membrane comprising an organic material obtained by saponification of a mixture of acetyl celluloses different from each other in acetyl value. As conceded at page 5 of the Office Action, Ekenberg and Mori do not teach the recited nucleic acid-adsorbing porous membrane, and as discussed above, the Iwaki reference relied on as teaching such a nucleic acid-adsorbing porous membrane is not available as prior art. Thus, Applicants respectfully request the rejections of claims 1, 2, 7-18, 20, 22-23 and 28-41 over Ekenberg and Mori be withdrawn.

**Rejections under 35 U.S.C. § 103(a)**

Claims 3, 4, 24 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ekenberg in view of Mori. Claims 3, 4, 24 and 25 have been cancelled and their rejection is moot.

Claims 5 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ekenberg in view of Mori and in further view of Iwaki. Claims 5 and 26 have been cancelled and their rejection is moot.

Claims 19 and 42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ekenberg in view of Mori and the Stratagene Catalog, p. 39, 1988 (hereinafter “the Stratagene Catalog”). Claim 19 has been rejected and its rejection is moot.

Amended claim 42 recites a nucleic acid-adsorbing porous membrane comprising an organic material obtained by saponification of a mixture of acetyl celluloses different from each other in acetyl value. As explained above, it is conceded at page 5 of the Office Action that Ekenberg and Mori do not teach the recited nucleic acid-adsorbing porous membrane. The

Stratagene Catalog also does not teach the recited nucleic acid-adsorbing porous membrane. Thus, taken alone or together, Ekenberg, Mori and the Stratagene Catalog do not teach every element of the claimed invention. Applicants respectfully request that the rejection of claim 42 as being obvious over Ekenberg in view of Mori and the Stratagene Catalog be withdrawn.

**Duplicate Claims-Warning**

Applicants thank the Examiner for pointing out in advance that should claim 19 be found allowable, claim 42 will be objected to under 37 C.F.R. § 1.75 as being a substantial duplicate thereof. Applicants have cancelled claim 19 without prejudice or disclaimer of the subject matter contained therein.

**CONCLUSION**

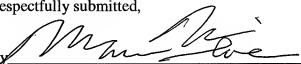
All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Stephanie A. Wardwell, Ph.D., Registration No. 48,025, at the telephone number of the undersigned below to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

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Respectfully submitted,

By 

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